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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,043	12/05/2003	Scott Goldthwaite	WS-104	9327
27769 AKC PATENTS 215 GROVE ST. NEWTON, MA 02466	7590 04/29/2008			
EXAMINER				
VYAS, ABHISHEK				
ART UNIT		PAPER NUMBER		
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04/29/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/729,043

**Applicant(s)**

GOLDTHWAITE ET AL.

**Examiner**

ABHISHEK VYAS

**Art Unit**

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

**Status of Claims**

1. This action is in reply to the remarks and arguments filed on 01/08/2008.
2. Claim 1-45 are currently pending and have been examined.
3. Claims 1-45 are rejected. This action is **FINAL**.

***Claim Rejections. 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-11, 13, 15-19, 22, 23, 25-34, 36, 38-42 and 45** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gobburu et al. United States Patent No.: 6,736,322 B2, in view of Young et al. United States Patent Application Publication No.: US 2002/0065774 A1 as set forth in previous office action.
6. **Claims 12, 14, 20, 35, 37 and 43** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gobburu et al. United States Patent No.: 6,736,322 B2, and Young et al. United States Patent Application Publication No.: US 2002/0065774 A1 as applicable to claims 1 and 23 above and in further view of Jacobson United States Patent Application Publication No.: US 2003/0004876 A1 as set forth in previous office action.

7. **Claims 21, 24, and 44** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gobburu et al. United States Patent No.: 6,736,322 B2, and Young et al. United States Patent Application Publication No.: US 2002/0065774 A1 as applicable to claims 1 and 23 above and in further view of Kelly et al United States Patent No.: 5,816,918 as set forth in previous office action.

***Response to Arguments***

8. Applicant's arguments filed 01/08/2008 have been fully considered but they are not persuasive.
9. **In regards to item A:** The applicant argues, "*The Young et al patent does not teach a communication device comprising a payment card module wherein said payment card module is adapted to receive a payment card and read payment card identification information stored in said payment card*". Young, however, in paragraphs 0040, 0057 and 0060, discloses a user may input data related to another means of payment, and the electronic wallet comprising payment data previously entered by the user. Using the broadest reasonably possible interpretation for the claims as recited, Young discloses an electronic wallet where payment data is entered and accessible by the phone for future use. Further, "*a payment card module comprising a payment card reader and writer module*" as claimed are addressed as disclosed by Gobburu, Young and Jacobson. Jacobson, in paragraphs 0020, 0023 discloses the limitations.
10. **In response to item B:** Applicant argues that the Young reference fails to show certain features of applicant's invention, (i.e., purchasing of digital goods). The Gobburu reference however, as discloses the limitations of a digital good in column 20, lines 46-53). The rejection is based on the combination of Gobburu and Young. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 208 USPQ 871 (CCPA 1981)
11. **In regards to item C:** It is argued that "*Young et al do not teach, the fulfillment server transmits the digital good via the authentication server to the communication device*". Kelly, however, teaches the limitations in column 11, lines 24-34, column 15, lines 32-38 and column 28, lines 7-

11. The rejection is based on the combination of Gobburu, Young and Kelly. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 208 USPQ 871 (CCPA 1981).

12. **In response to item D:** *"Young et al do not teach storing the digital good onto the payment card, whereas claim 1 of the present invention does; see claim 1 "wherein the communication device stores the digital good onto the payment card".* Kelly, however, teaches the limitations in column 11, lines 24-34, column 15, lines 32-38 and column 28, lines 7-11. The rejection is based on the combination of Gobburu, Young and Kelly. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 208 USPQ 871 (CCPA 1981).

13. **In regards to item E:** It is argued that Gobburu et al do not disclose the limitations of *"merchant server", "payment server", "authentication server" and "communication device"*. Gobburu et al disclose the limitations as follows:

- Merchant server: (see at least Gobburu column 18, line 8)
- Payment and authentication server: (see at least Gobburu column 18, line 11-13, 17-19)
- Communication device: (see at least Gobburu column 18, line 20-22, 28)

It is further argued that Gobburu "has nothing to do with the present invention. Furthermore, this is so far removed from the Young et al patent, that there is no reason or motivation to combine it with the Young et al patent, as the Examiner argued." In response it is noted that one cannot show nonobviousness by attacking references individually (Young et al) where the rejections are based on combinations of references *In re Keller*, 208 USPQ 871 (CCPA 1981). Further, the test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references; rather, test is what combined teachings of references would have suggested to those of ordinary skill in art *In re Keller*, 208 USPQ 871 (CCPA 1981).

14. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Gobburu, Young, Jacobson and Kelly teach mobile devices, wired and wireless networks; purchasing goods over the internet; a mobile device capable of reading internally or externally, payment information; authorization or authentication, and order confirmation.
15. It is further alleged, that the Jacobson reference is not an appropriate reference as it was first published in January 2 2003. However, it is noted that the filing date of the Jacobson reference is June 21 2001. This is still an appropriate reference as the filing date (June 21 2001), under 102(e), appropriately precedes the priority date (12/06/2002) of the instant application. Engaging a broadest reasonable interpretation, the references when combined teach the limitations of the claims as presented with the response filed on 01/08/08. The claims as interpreted are not patentably distinguishable. In light of the response to the arguments above and the claim rejections discussed in the previous office action; the applicant's request for placing claims 1-45 in condition for allowance is respectfully declined.

### ***Conclusion***

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of

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this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abhishek Vyas whose telephone number is 571-270-1836. The examiner can normally be reached on 7:30am-5:00pm EST Mon-Thur, ALT Friday OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Abhishek Vyas  
Patent Examiner  
April 17, 2008  
AV

/Lalita M Hamilton/  
Primary Examiner, Art Unit 3691